

REMARKS

This Response is filed in response to the to the non-final Office Action mailed February 24, 2004.

Claims 1-13, 15-17, and 24-39 are pending in the application. Claims 1-9, 11-13, 15-17, 24-28, 31-35, 37, and 39 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,199,587 to Shlomi, *et al.* (hereinafter "Shlomi"). Claims 36 and 38 stand rejected under 36 U.S. C. 103(a) as being unpatentable over Shlomi in view of U.S. Patent No. 5,857,492 to Salamun (hereinafter "Salamun"). Claims 10, 29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully traverses the Examiner's rejections. Reconsideration of the present application is respectfully requested in view of the following remarks.

I. Claims 1-9, 11-13, 15-17, 24-28, 31-35, 37, and 39

Claims 1-9, 11-13, 15-17, 24-28, 31-35, 37, and 39 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Shlomi. To reject a claim as anticipated under 102(e), the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See, MPEP § 2131. The rejection is traversed because the cited reference neither teaches nor suggests every aspect of the claimed invention.

Claim 1, as amended, claims an electromagnetic actuator comprising "an elastic material disposed in said gap [between the magnet and the core] *and configured to limit a range of motion of said magnet.*" Shlomi neither teaches nor suggests, "an elastic material disposed in said gap [between the magnet and the core] *and configured to limit a range of motion of said magnet.*"

Shlomi describes a solenoid valve for controlling a flow of fluid. Referring to Figure 19, the valve includes "a member 658 which is made of non-ferrous material having conduits." Column 15, lines 57-58. The conduits are for carrying fluid across a plunger. Column 6, lines 43-44. The non-ferrous material is not "*configured to limit a range of motion of said magnet.*"

Accordingly, Shlomi neither teaches nor suggests every aspect of the claimed invention, and claim 1 is allowable.

Claims 2-10, 24, 25, 35, and 36 depend from claim 1. Accordingly, for at least the reasons stated above in relation to claim 1, claims 2-10, 24, 25, 35, and 36 are allowable as well. Applicant respectfully requests that the Examiner withdraw the rejection of claims 2-9, 24, 25, 35, and 36 and the objection to claim 10.

In claims 11 and 31, as amended, Applicant claims an electromagnetic actuator comprising "a first flexible member *attached to said core member and said magnet.*" Shlomi neither teaches nor suggests "a first flexible member *attached to said core member and said magnet.*" In Shlomi, the non-ferrous material is not attached to the core member. *See, e.g., Figure 19.* Shlomi neither teaches nor suggests every aspect of the claimed invention. Accordingly, claims 11 and 31 are allowable.

Claims 12, 13, 15, 16, 17, 26-30, 37, and 38 depend from claim 11. Accordingly, for at least the reasons stated above in relation to claim 11, claims 12, 13, 15, 16, 17, 26-30, 37, and 38 are allowable as well. Applicant respectfully requests that the Examiner withdraw the rejection of claims 12, 13, 15, 16, 17, 26-28, 37, and 38 and the objection to claims 29 and 30.

Claims 32, 33, and 34 depend from claim 31. Accordingly, for at least the reasons stated above in relation to claim 31, claims 32, 33, and 34 are allowable as well. Applicant respectfully requests that the Examiner withdraw the rejection of claims 32, 33, and 34.

II. Claims 36 and 38

Claims 36 and 38 stand rejected under 36 U.S. C. 103(a) as being unpatentable over Shlomi in view of Salamun. To establish a prima facie case of obviousness, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See, MPEP 2142.* Applicant respectfully asserts that the Examiner has failed to establish a prima facie case of obviousness, as is required by MPEP §2142.

Claim 36 depends from claim 1. As shown in relation to claim 1, Shlomi fails to teach of all the claim limitations of claim 1. Accordingly, for at least the reasons stated above in relation to claim 1, claim 36 is allowable. Applicant respectfully requests that the Examiner withdraw the rejection of claim 36.

Claim 38 depends from claim 11. As shown in relation to claim 11, Shlomi fails to teach of all the claim limitations of claim 11. Accordingly, for at least the reasons stated above in relation to claim 11, claim 38 is allowable. Applicant respectfully requests that the Examiner withdraw the rejection of claim 38.

III. Claims 10, 29, and 30

Claims 10, 29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the indication that these claims would be allowable. However, each of the rejected base claims from which claims 10, 29, and 30 depend are allowable as shown above. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claims 10, 29, and 30.

IV. Ground Member/Grounded Surface

Examiner states "the inputs (636) with letters G and H where voltage can be applied and G represents the ground member attached to said core member." Office Action, page 3, paragraph 1. Examiner makes similar references throughout the Office Action. See, e.g., page 3, paragraph 5. Respectfully, when Applicant claims a "ground member" or "grounded surface," Applicant is claiming a mechanical rather than an electrical ground. See, e.g., Specification, page 11, lines 32-33.

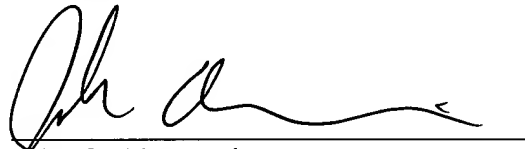
Appl. No. 09/608,130
Filed: June 30, 2000

Express Mail No. EV 367 777 608 US
Attorney Docket No.: IMM086B
PATENT

CONCLUSION

Applicant respectfully submits that claims 1-13, 15-17, and 24-39 are allowable. A favorable Office Action is respectfully solicited. The Examiner is invited to contact the undersigned at 336-607-7311 to discuss any matter related to the application.

Respectfully submitted,



John C. Alemanni
Attorney for Applicant
Registration No. 47,384

Date: May 24, 2004

Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101
(336) 607-7311 (voice)
(336) 734-2621 (facsimile)

51851-279732
WINLIB01:1072619.1